The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TADASHI OHTAKE, NORIHISA MINO and KAZUFUMI OGAWA

Appeal No. 1998-1625
Application 08/306,517

ON BRIEF

Before PAK, OWENS and PAWLIKOWSKI, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 6, 7, 9 and 11-13, which are all of the claims remaining in the application.

THE INVENTION

The appellants claim a method of manufacturing a chemically adsorbed film. Claim 13 is illustrative:

13. A method of manufacturing a chemically adsorbed film, which film comprises graft molecules and stem molecules, said method comprising:

(a) providing a substrate surface, wherein said surface comprises active hydrogen atoms or an alkali metal,

(b) contacting said substrate surface with first chemical admolecules, said first admolecules containing at least one functional group shown in formula [A] or formula [B] and,

wherein said admolecules promote a dehydrochlorination or alcohol elimination reaction, so as to provide stem molecules covalently bonded to the substrate surface;

(c) removing unreached first chemical admolecules,

(d) reacting the substrate surface with water so as to substitute one or more members of the group consisting of a halogen group and an alkoxyl group with a hydroxyl group,

(e) contacting said substrate surface with second chemical admolecules containing at least one functional group selected from the group consisting of formulas [C], [D], [E], [F], and [G], and wherein said second admolecules promote one of a dehydrochlorination, water elimination or alcohol elimination reaction, removing unreached second chemical admolecules and reacting the substrate surface with water so as to provide graft molecules bonded to said stem molecules; wherein,

Formula [A] is -AXm,

where X represents a halogen, A represents Si, Ge, Sn, Ti, Zr, S or C, and m represents 2 or 3;

Formula [B] is -A(Q)m,

where Q represents an alkoxyl group, A represents Si, Ge, Sn, Ti, Zr, S or C, and m represents 2 or 3;

Formula [C] is -AXn,

where X represents a halogen, A represents Si, Ge, Sn, Ti, Zr, S or C, and n represents 1, 2 or 3;

Formula [D] is -A(Q)n,

where Q represents an alkoxyl group, A represents Si, Ge, Sn, Ti, Zr, S or C, and n represents 1, 2 or 3;

Formula [E] is SO_2X,

where X represents a halogen;

Formula [F] is SOX

where X represents a halogen; and

Formula [G] is >N-CHO or -OCHO.

THE REJECTION

Claims 6, 7, 9 and 11-13 stand rejected under 35 U.S.C. § 112, first paragraph, written description requirement.

OPINION

We reverse the aforementioned rejection.

A specification complies with the 35 U.S.C. § 112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the claimed invention. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978); *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). "[T]he PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims." *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

The examiner argues: "Graft and stem molecules are not described adequately enough that it can be clearly distinguished what is meant by graft and stem, and which

molecules in the claims are graft and which are stem" (answer, page 3).

The examiner's reasoning does not appear to be relevant to claims 6, 7, 9, 11 and 12 which, as acknowledged by the examiner (answer, page 4), do not include the terms "stem" and "graft". In any event, the examiner does not address the above-stated inquiry regarding whether the disclosure provides adequate written descriptive support for the invention recited in these claims.

As for claim 13, this claim (step e) recites that the graft molecules are bonded to the stem molecules. The specification (page 6) discloses "introducing graft molecules to the roots of stem molecules." The examiner does not explain why the appellants' disclosures such as this one would not have conveyed with reasonable clarity to those skilled in the art that, as of the filing date sought, the appellants were in possession of the claimed invention. The examiner, therefore, has not carried the burden of establishing a *prima facie* case of lack of adequate written description of the subject matter of claim 13.

For the above reasons, we find that the examiner has not established a *prima facie* case of inadequate written description of the invention recited in any of the appellants' claims. Accordingly, we reverse the examiner's rejection.

DECISION

The rejection of claims 6, 7, 9 and 11-13 under 35 U.S.C. § 112, first paragraph, written description requirement, is reversed.

REVERSED

CHUNG K. PAK)
Administrative Patent Judge)

TERRY J. OWENS	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
BEVERLY A. PAWLIKOWSKI	)	
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